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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,972	12/28/2000	Martin Karl Russel Burnham	GM10201-D1	7984

25308 7590 07/14/2004

DECHERT
ATTN: ALLEN BLOOM, ESQ
4000 BELL ATLANTIC TOWER
1717 ARCH STREET
PHILADELPHIA, PA 19103

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07/14/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,972

Applicant(s)

BURNHAM ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14 is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/28/00
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 11-22 are currently pending in this application which were suspended by the Examiner in view of a reference that was due to become available. The application has been removed from the suspended status as the reference has now become available. An Office action follows.

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on 11-6-01 is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Doucete-Stamm et al. (US 6,699,703). This rejection is based upon the public availability of a patent to another. Claims 15-22 of the instant application are drawn to a polynucleotide encoding a polypeptide comprising or consisting of SEQ ID NO:2, vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Doucete-Stamm et al. disclose a polynucleotide

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with SEQ ID NO:2480 that encodes a polypeptide (SEQ ID NO:5141) that is 100% identical to SEQ ID NO :2 (see enclosed sequence alignment) along with vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Therefore Doucete-Stamm et al. anticipate claims 15-22 as written.

Claims 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Barash et al. (WO 9818931-A2, 5-7-1998). This rejection is based upon the public availability of a publication. Claims 15-22 of the instant application are drawn to a polynucleotide encoding a polypeptide comprising or consisting of SEQ ID NO:2, vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Barash et al. disclose a polynucleotide which encodes a polypeptide that is 100% identical to SEQ ID NO :2 (see enclosed sequence alignment that is identical to that disclosed by Doucete-Stamm et al.) along with vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Therefore Barash et al. anticipate claims 15-22 as written.

Allowable Subject Matter

Claim 11-14 are allowable.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization

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where this application or proceeding is assigned is 703-872-9306 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read "Manjunath N. Rao". The signature is fluid and cursive, with a large initial "M" and a long, sweeping underline.

Manjunath N. Rao
July 6, 2004

121 NQATDGLKPDILTYFDIEVEEGLIARIANSDBREVNRLDLEGLDLHKVROGYLSLDKE 180
Db 121 NQATDGLKPDILTYFDIEVEEGLIARIANSDBREVNRLDLEGLDLHKVROGYLSLDKE 180
QY 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212
Db 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212

RESULT 2

US-09-583-110-5141

Sequence 5141, Application US/09583110

→ NOW US 6,699703B1.

GENERAL INFORMATION:

APPLICANT: Lynn Doucette-Stamm et al.

TITLE OF INVENTION: Nucleic Acid and Amino Acid Sequences Relating to Streptococcus

TITLE OF INVENTION: Pneumoniae for Diagnostics and Therapeutics

FILE REFERENCE: PAT00-07A

CURRENT APPLICATION NUMBER: US/09/583,110

CURRENT FILING DATE: 2000-05-26

PRIOR APPLICATION NUMBER: US 09/107,433

PRIOR FILING DATE: 1998-06-30

PRIOR APPLICATION NUMBER: US 60/085,131

PRIOR FILING DATE: 1998-05-12

PRIOR APPLICATION NUMBER: US 60/051,553

PRIOR FILING DATE: 1997-07-02

NUMBER OF SEQ ID NOS: 5322

SEQ ID NO 5141

LENGTH: 212

TYPE: PRT

ORGANISM: Streptococcus pneumoniae

US-09-583-110-5141

Query Match

Best Local Similarity

Matches 212; Conservative

100.0%; Score 1053; DB 19; Length 212;

Pred. No. 5,9e-100;

Mismatches 0; Indels 0; Gaps 0;

QY 1 MSKGFLVSLGPEGAGKTSVLEALLPILTEKGEVLTTRPGGVLTGKIREVILDPST 60

Db 1 MSKGFLVSLGPEGAGKTSVLEALLPILTEKGEVLTTRPGGVLTGKIREVILDPST 60

QY 61 QMDATTELLLYTASRQHVYKVPALVLEAGKLYIMDRFTDSSVAYQFGFGLDIEAIDWL 120

Db 61 QMDATTELLLYTASRQHVYKVPALVLEAGKLYIMDRFTDSSVAYQFGFGLDIEAIDWL 120

QY 121 NQATDGLKPDILTYFDIEVEEGLIARIANSDBREVNRLDLEGLDLHKVROGYLSLDKE 180

Db 121 NQATDGLKPDILTYFDIEVEEGLIARIANSDBREVNRLDLEGLDLHKVROGYLSLDKE 180

QY 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212

Db 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212

QY 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212

Db 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212

OY 241 gaaaaagttcttcacagcccttgaagctggcaagtgtgcatcatgatacgtttatcgaat 300
 CC |||||||
 DB 241 gaaaaagttcttcacagcccttgaagctggcaagtgtgcatcatgatacgtttatcgaat 300
 OY 301 agttcgttgcatacaagagattgtctgtgcttgcataatgaacattgactgctc 360
 CC |||||||
 DB 301 agttcgttgcatacaagagattgtctgtgcttgcataatgaacattgactgctc 360
 OY 361 aatcagtttgcacagatgtgctcaaacccgatttgcacactatttgcacatcgagtg 420
 CC |||||||
 DB 361 aatcagtttgcacagatgtgctcaaacccgatttgcacactatttgcacatcgagtg 420
 OY 421 gaagaaggtcgtcgtctgtattgtctgataatgagaccgagattatgattgattg 480
 CC |||||||
 DB 421 gaagaaggtcgtcgtctgtattgtctgataatgagaccgagattatgattgattg 480
 OY 481 gaaggttgcactgtcgtataaaagtgcgaagctacattctcttcgtgataaagag 540
 CC |||||||
 DB 481 gaaggttgcactgtcgtataaaagtgcgaagctacattctcttcgtgataaagag 540
 OY 541 ggaatcgcactgtcgaagatgtatgtctagctcccttggagcaagtgtggaactacc 600
 CC |||||||
 DB 541 ggaatcgcactgtcgaagatgtatgtctagctcccttggagcaagtgtggaactacc 600
 OY 601 aagcgtctctgttgcaggaatgaggtctggccaatga 639
 CC |||||||
 DB 601 aagcgtctctgttgcaggaatgaggtctggccaatga 639
 DB 601 aagcgtctctgttgcaggaatgaggtctggccaatga 639
 RESULT 3
 AAV52155
 ID AAV52155 standard; DNA: 28171 BP.
 XX AAV52155;
 AC 23-OCT-1998 (first entry)
 XX
 DE Streptococcus pneumoniae genome fragment SEQ ID NO:22.
 XX
 KM Streptococcus pneumoniae; S. pneumoniae; genome; diagnosis; assay;
 KM computer readable medium; vaccine; pharmaceutical composition; ds.
 XX
 OS Streptococcus pneumoniae.
 XX
 PN MO9818931-A2.
 XX
 PD 07-MAY-1998.
 XX
 PF 30-OCT-1997; 97WO-US19588.
 XX
 PR 31-OCT-1996; 96US-0029960.
 XX
 PA (HDMA-) HDMA GENOME SCI INC.
 XX
 PI Barash SC, Choi GH, Dillon PJ, Dougherty BA, Fannon M;
 PI Kunsch CA, Rosen CA;
 XX
 DR WPI; 1998-27225/24.
 XX
 PT Computer-readable medium with recorded Streptococcus pneumoniae
 PT polynucleotide sequences - useful in diagnostic kits and assays, and
 PT pharmaceutical compositions and vaccines for Streptococcus
 PT pneumoniae
 XX
 PS Claim 1; Page 273-289; 1409pp; English.
 XX
 CC The present invention describes a computer readable medium which has
 CC the nucleotide sequences SEQ ID NO:1 to 391 (AAV52134 to AAV52524)
 CC recorded on it, or a representative fragment or a sequence at least 95%
 CC identical to SEQ ID NO:1 to 391. The nucleotide sequences depicted in
 CC SEQ ID NO:1 to 391 (AAV52134 to AAV52524) are genomic fragments from
 CC Streptococcus pneumoniae. The present invention also describes an
 CC isolated nucleic acid molecule encoding a homologue of any of the

CC fragments of the S. pneumoniae
 CC nucleic acid molecule is prod
 CC a genomic DNA library using a-
 CC of the sequences in SEQ ID NO:1 to 391, identifying members of the
 CC library which contain sequences that hybridize to the target sequence and
 CC isolating the nucleic acid molecules from the members; or (b) isolating
 CC mRNA, DNA or cDNA produced from an organism, amplifying nucleic acid
 CC molecules whose nucleotide sequence is homologous to amplification
 CC primers derived from the fragment of the S. pneumoniae genome to prime
 CC the amplification and isolating the amplified sequences. The computer
 CC readable medium can be used in a computer-based system for identifying
 CC fragments of the S. pneumoniae genome of commercial importance, or
 CC expression modulating fragments of the S. pneumoniae genome. Products
 CC from the present invention can be used in diagnosis kits and assays, and
 CC pharmaceutical compositions and vaccines for S. pneumoniae.
 XX
 SQ Sequence 28171 BP; 8507 A; 5080 C; 6440 G; 8144 T; 0 other;
 Query Match 99.5%; Score 635.8; DB 19; Length 28171;
 Best Local Similarity 99.7%; Pred No. 2.3e-190;
 Matches 637; Conservative 0; Mismatches 2; Indels 0; Gaps 0;
 OY 1 atgcataaagatttttagctctctcttgcaggaagcagaggaagcaggaagcagagtg 60
 CC |||||||
 DB 8013 atgcataaagatttttagctctctcttgcaggaagcagaggaagcaggaagcagagtg 60
 OY 61 tttagagctctgtaccatttttagaggaagaggtatgaggtgttgcagaccgtga 120
 CC |||||||
 DB 8073 tttagagctctgtaccatttttagaggaagaggtatgaggtgttgcagaccgtga 120
 OY 121 cctggcggagctcttgcattggaggaagattcgggaagctgatttgcatacctact 180
 CC |||||||
 DB 8133 cctggcggagctcttgcattggaggaagattcgggaagctgatttgcatacctact 180
 OY 8133 cctggcggagctcttgcattggaggaagattcgggaagctgatttgcatacctact 8192
 DB 8133 cctggcggagctcttgcattggaggaagattcgggaagctgatttgcatacctact 8192
 OY 181 cagatgagctctaaacagagctactctctatattgcagctgcagacagcattgtg 240
 CC |||||||
 DB 8193 cagatgagctctaaacagagctactctctatattgcagctgcagacagcattgtg 240
 OY 241 gaaaaagttcttcacagcccttgaagctggcaagtgtgcatcatgatacgtttatcgaat 300
 CC |||||||
 DB 8253 gaaaaagttcttcacagcccttgaagctggcaagtgtgcatcatgatacgtttatcgaat 300
 OY 301 agttcgttgcatacaagagattgtctgtgcttgcataatgaacattgactgctc 360
 CC |||||||
 DB 8313 agttcgttgcatacaagagattgtctgtgcttgcataatgaacattgactgctc 360
 OY 361 aatcagtttgcacagatgtgctcaaacccgatttgcacactatttgcacatcgagtg 420
 CC |||||||
 DB 8373 aatcagtttgcacagatgtgctcaaacccgatttgcacactatttgcacatcgagtg 420
 OY 421 gaagaaggtcgtcgtctgtattgtctgataatgagaccgagattatgattgattg 480
 CC |||||||
 DB 8433 gaagaaggtcgtcgtctgtattgtctgataatgagaccgagattatgattgattg 480
 OY 481 gaaggttgcactgtcgtataaaagtgcgaagctacattctcttcgtgataaagag 540
 CC |||||||
 DB 8493 gaaggttgcactgtcgtataaaagtgcgaagctacattctcttcgtgataaagag 540
 OY 541 ggaatcgcactgtcgaagatgtatgtctagctcccttggagcaagtgtggaactacc 600
 CC |||||||
 DB 8553 ggaatcgcactgtcgaagatgtatgtctagctcccttggagcaagtgtggaactacc 600
 OY 601 aagcgtctctgttgcaggaatgaggtctggccaatga 639
 CC |||||||
 DB 8613 aagcgtctctgttgcaggaatgaggtctggccaatga 8651
 RESULT 4
 AAV52155
 ID AAV52155 standard; DNA: 1632 BP.
 XX
 AC AAV52155;